UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,788	01/18/2002	Motoi Sato	13700-269115	4278

23370   7590   03/14/2008

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EXAMINER
DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
03/14/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/053,788	SATO ET AL.
	Examiner	Art Unit	
	Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _04 February 2008_.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-18_ is/are pending in the application.
  4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1-18_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  a)☐ All   b)☐ Some * c)☐ None of:
    1.☐ Certified copies of the priority documents have been received.
    2.☐ Certified copies of the priority documents have been received in Application No. _____.
    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-18 have been examined.

Response to Amendment

2.   The Remarks filed on 2/4/08 are insufficient to overcome the prior rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greening

(2001/0013009) in view of McCarthy (20050288954).

Claims 1, 9, 17, 18: Greening discloses a recommended item presentation method,

comprising the steps of:

(a) obtaining client identifier associated client preference estimating factor

information of a plurality of clients which is information according to which a

preference of each client is to be estimated; and

(b) receiving a recommended item presentation request and a client preference estimating

factor information of one client from an item provider server for providing items to a plurality

of clients through a network, where the client preference estimating factor

information indicates a preference of the one client, producing a recommended item list

according to the client identifier associated client preference estimating factor information and

the client preference estimating factor information, and transmitting the

recommended item list to the item provider server (Abstract; Figures 1, 2, 4, 6, 7, 11).

Additionally, note that Applicant's own Specification states that many of the features of

the Applicant's claims are obvious, old and well known (Sato, Figures 14 and 15; Paragraphs [1-

25]). Also, in the Applicant's Remarks dated 9/20/2007 on page 11, Applicant states that

Greening discloses, "Greening discloses a system that predicts the interest of a user in specific

items, by directly using information which identifies each client and is directly obtained from

each client, similar to (1) described above."

Greening does not explicitly disclose without identifying the one client or that the

recommended item list suitable for the one client is provided to the item provider server without

requiring any information for identifying the one client from the item provider server.

However, McCarthy discloses recommendations for both non-anonymous and

anonymous users and McCarthy discloses without identifying the one client or that the

recommended item list suitable for the one client is provided without requiring any information

for identifying the one client from the server ([207]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made that McCarthy's anonymous users can receive recommendations that are

mapped to the preferences of the known users in Greening. One would have been motivated to

do this in order to better make recommendations to known and unknown users.

Additionally, McCarthy discloses predicting user interests without identifying the user

and also without using IP address or a client identifier ([192, 200]; Figures 12, 13, 10). Notice in

[200] that the action targeting performs without identifying the user/client, "or commonly

assigned profiles built using demographic of like consumers of the particular product if no

profile is available". Also, note that [192] performs without identifying the user/client. Notice

in ([192, 200]) that in a session that a user is active in that the activities of that user are tracked

for that session, without identifying the user/client, and that the unidentified user's activities are

compared with a known set of legacy users in order to better profile and target the current

unidentified user.

Also, Greening further discloses, "regarding particular items accessed by the one client. .

. by using the client preference estimating factor information as a key for obtaining related

clients and related items from the client identifier associated client preference estimating factor

information, and transmitting" (Figures 1, 3, 4).

Greening further discloses receiving a request from an item provider server ([50, 126]).

Claim 2, 10: The combination of the prior art discloses the above. Greening further

discloses that the step (a) obtains the client identifier associated client preference estimating

factor information by receiving a client preference estimating factor information list

from a client preference estimating factor information list providing server

which collects the client identifier associated client preference estimating

factor information from a plurality of clients (Abstract, [15]).

Claims 3, 11: The combination of the prior art discloses the above. Greening further

discloses that the step (a) receives the client identifier associated client preference estimating

factor information list in a form of a list of item identifiers of viewed/purchased

items at the item provider server and dates and times of viewings/purchases of

the viewed/purchased items for each client identifier, or a list of item

identifiers of viewed/purchased items at the item provider server and ratings

indicating levels of interest of each client with respect to the

viewed/purchased items for each client identifier, or a list of item

identifiers of interested items of each client for each client identifier (Abstract, [15]).

Claim 4, 5, 12, 13: The combination of the prior art discloses the above. Greening does

not explicitly disclose the step of paying a fee for transmission of the client identifier associated

client preference estimating factor information list to the client preference

estimating factor information list providing server.

Greening does not explicitly disclose the step of receiving a fee for transmission of the

recommended item list from the item provider server.

However, Sato (Applicant's Own Specification) states that it is obvious, old and well

known that fees can be charged for advertising, recommendations, or other provided services

(Sato, [22]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was that a fee can be charged for providing relevant information. One would have

been motivated to do this in order to better provide a source of revenue.

Claims 6, 14: The combination of the prior art discloses the above. Greening further

discloses that the step (a) also processes the client identifier associated client preference

estimating factor information into a client preference estimating factor information map

and the step (b) produces the recommended item list according to the client

preference estimating factor information map and the client preference

estimating factor information (Abstract; Figures 11, 3, 1, 2, 4, 6, 7).

Claims 7, 15: The combination of the prior art discloses the above. Greening further

discloses that the step (a) produces the client preference estimating factor information map in a

form of any of a list of item identifiers of accessed items of each client for each

client identifier, a list of item identifiers of accessed items of each client

and ratings indicating levels of interest of each client with respect to the

accessed items for each client identifier, a list of client identifiers of

accessing clients of each item for each item identifier, a list of client

identifiers of accessing clients of each item and ratings indicating levels of

interest of each client with respect to each item for each item identifier, and

a list of correlation values among correlated items (Abstract; Figures 11, 3, 1, 2, 4, 6, 7).

Claims 8, 16: The combination of the prior art discloses the above. Greening further

discloses that the step (b) produces the recommended item list by: obtaining a related client list

by extracting client identifiers contained in a list of client identifiers for

each item that constitutes the client preference estimating factor information

map, for each item identifier in a list of item identifiers that constitutes

the client preference estimating factor information received along with the

recommended item presentation request from the item provider server; narrowing

down the related client list by extracting item identifiers contained in a list

of item identifiers for each client that constitutes the client preference

estimating factor information map, for each client identifier in, the related

client list, counting a number of overlaps between extracted item identifiers

and item identifiers in the list of item identifiers that constitutes the

client preference estimating factor information, for each client identifier in

the related client list, rearranging client identifiers in the related client

list in a descending order of counted number of overlaps, and setting a first

prescribed number of client identifiers from a top of a rearranged related

client list as a new related client list; obtaining a related item list by

extracting item identifiers contained in the list of item identifiers for each

client, for each client identifier in the new related client list; and

narrowing down the related item list by extracting client identifiers contained

in the list of client identifiers for each item, for each item identifier in

the related item list, counting a number of overlaps between extracted client

identifiers and client identifiers in the new related client list, for each

item identifier in the related item list, rearranging item identifiers in the

related item list in a descending order of counted number of overlaps, and

setting a second prescribed number of item identifiers from a top of a

rearranged related item list as the recommended item list (Greening, Figures 1, 4-11; [18, 42,

43, 45, 68, 69]).

Response to Arguments

4.   Applicant's arguments with respect to the claims have been considered but are not found

persuasive.

Beginning on page of the Applicant's Remarks dated 2/4/08 Applicant states:

"The "anonymous" users of McCarthy are identified by IP address and predictive

suggestions are based on click stream and physiologic responses, thus McCarthy does not

disclose a client preference estimating factor information that indicates a preference of the one

client "without identifying the one client." McCarthy does not disclose or suggest providing a

recommendation suitable for a particular client "without requiring any information for

identifying" the particular client, because the users of McCarthy are identified by IP address."

However, McCarthy discloses predicting user interests without identifying the user and

also without using IP address or a client identifier ([192, 200]; Figures 12, 13, 10). Notice in

[200] that the action targeting performs without identifying the user/client, "or commonly

assigned profiles built using demographic of like consumers of the particular product if no

profile is available". Also, note that [192] performs without identifying the user/client. Notice

in ([192, 200]) that in a session that a user is active in that the activities of that user are tracked

for that session, without identifying the user/client, and that the unidentified user's activities are

compared with a known set of legacy users in order to better profile and target the current

unidentified user.

In regards to the new features added on 2/4/2008, Greening further discloses, "regarding

particular items accessed by the one client. . . by using the client preference estimating factor

information as a key for obtaining related clients and related items from the client identifier

associated client preference estimating factor information, and transmitting" (Figures 1, 3, 4).

In regards to arguments on page 11, Greening does disclose receiving a request from an

item provider server ([50, 126]).

In regards to the comments concerning dependent claims 6-8, Examiner notes that the

dependent claim rejections assume what has already been shown in the independent claims.

Hence, Examiner notes that while specific references were made to the prior art, it is actually

also the prior art in its entirety and the combination of the prior art in its entirety that is being

referred to. Also, one cannot show nonobviousness by attacking references individually where

the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Also, when there is a design need or market pressure to solve a problem and there are a

finite number of identified, predictable solutions, a person of ordinary skill has good reason to

pursue the known options within his or her technical grasp. If this leads to the anticipated

success, it is likely the product not of innovation but of ordinary skill and common sense. In that

instance the fact that a combination was obvious to try might show that it was obvious under

§103.

If a person of ordinary skill in the art can implement a predictable variation, and would

see the benefit of doing so, §103 likely bars its patentability. Moreover, if a technique has been

used to improve one device, and a person of ordinary skill in the art would recognize that it

would improve similar devices in the same way, using the technique is obvious unless its actual

application is beyond that person's skill. KSR Int'l Co. v. Teleflex, Inc., No 04-1350 (U.S. Apr. 30, 2007).

Also, KSR states that it is obvious to recite combination which only unite old elements with no change in their respective functions and which yield predictable results. KSR, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

aa) Jacobi discloses recommendations to a new, unknown shopper; Engberg discloses recommendations to an anonymous user ([29, 194]); as does Linden ([199]); as does Goldstein ([55, 57], claims 6, 7);

a) Bieganski (6,321,221), Lokuge (5,907,836), Sumita (5,907,836) disclose recommendation inventions with relevant features;

b) Dedrick (5,724,521) and Goldhaber (5,794,210) disclose charging for information providing and protecting user privacy.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The

examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arthur Duran
Primary Examiner
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2/27/2008